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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/911,142	07/23/2001	Reto Sieber	F-7086	4481

7590

07/14/2003

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EXAMINER

EGAN, BRIAN P

ART UNIT

PAPER NUMBER

1772

DATE MAILED: 07/14/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/911,142

Applicant(s)

SIEBER ET AL.

Examiner

Brian P. Egan

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 4/11/03 and 4/28/03 (Sup. Amend.).
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 April 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 11. 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. The proposed drawing (Fig. 5), filed on 4/11/03 has been accepted by the Examiner.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 7, 9, 25, and 27 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Although the specification states that an intermediate layer is provided at least at the folded side of the roll, the newly filed Fig. 5 along with the definition provided in the Applicant's remarks in paper no. 8 fail to properly distinguish the intermediate layer and it is not defined or described in the specification in such a way as to enable one skilled in the art to use the invention. Paper no. 8 states that "from the plain language of the specification and a review of the drawings, it is clear that the folded side is the side of the tape when the tape is folded." This definition is unclear. "The side of the tape when the tape is folded" could refer to the top side of the tape, the bottom side of the tape, or the edge region of the tape. Is the Applicant intending the "side of the tape when the tape is folded" to be the front or bottom surface of the tape, or is the Applicant defining the side of the tape to be the edge region of the roll? The newly

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submitted Fig. 5 labels the intermediate layer as #10 and it appears as if #10 is directed at the top surface of the tape. Furthermore, the “means... for preventing adhesion to the dispenser,” which appear to be equivalent to the intermediate layer, are not adequately defined as to enable one skilled in the art to make or use the invention.

Although the intermediate layer/protective means remains non-enabling since it is unclear where exactly the intermediate layer/protective means are located, the Examiner does note that if the Applicant intends the intermediate layer/protective means to be defined as a layer that is along the edge region of the roll of tape, it is notoriously well known in the art to provide adhesive rolls with protective sidewalls for the purpose of facilitating proper application of the tape as evidenced by Packard (#5,735,400), Scholz et al. (#6,074,747), Behrens et al. (#6,145,722), and Clark et al. (#5,678,689).

Proper clarification and/or correction are required.

4. Claim 8 remains rejected under 35 U.S.C. 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as his invention. The phrase, “adapted for” is indefinite. Either the dispenser is for unrolling the tape or it is not. Proper clarification and/or correction are required.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-3, 5-6, 10-12, 14-16, 19-21, 23-24, and 28-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vitale (#4,792,473) in view of Hibler (#6,001,200) and Tuoriniemi (#6,444,307).

Vitale teaches a pressure sensitive tape for closing, sealing, or gluing joints in house construction, including joints in corners and edges (Col. 1, lines 5-22), comprising a backing layer (Fig. 1, #12), an adhesive layer supported by the backing layer (Fig. 1, #14), and a peelable protective film resting on the adhesive layer (Fig. 1, #18). The backing comprises paper (which is an open pored material) (Col. 1, lines 59-60) that exhibits good adhesion properties for plaster ("gypsum"; Col. 1, line 67 to Col. 2, line 10) and the adhesive layer is a pressure-sensitive acrylate adhesive (Col. 3, line 16-17). The adhesive layer has a non-adhering central strip (Col. 3, lines 32-33). The tape is at least 3 to 4cm wide when not folded (Col. 2, lines 47-49). The backing comprises a longitudinal section comprising circular perforations with an average diameter of at least 3 millimeters (Col. 2, lines 60-64). The adhesive tape is in the form of a roll (Col. 3, lines 47-50).

Vitale fails to teach the protective layer comprising multiple slits and the tape being folded upon itself in a transverse direction along a slit.

Hibler, however, teaches a protective tape for protecting corners wherein the protective film is slit ("scored") along the adhesive portions of the substrate. Hibler teaches the use of slits along the protective film layer for the purpose of allowing one side of the liner to be peeled and the tape aligned with the corner and then to subsequently allow the second side of the liner to be peeled and pressed on the remainder of the corner (Col. 4, lines 30-35). It would have been obvious through routine experimentation to one of ordinary skill in the art at the time applicants

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invention was made, motivated by the desire to properly adhere a tape along the corner portion of a wall, to have provided slits along the adhesive portions a protective film layer of a tape substrate for the purpose of allowing one side of the liner to be peeled and the tape aligned with the corner and then to subsequently allow the second side of the liner to be peeled and pressed on the remainder of the corner as taught by Hibler.

Therefore, it would have been obvious to one of ordinary skill in the art at the time applicants invention was made to have modified Vitale by slitting the protective film layer along each adhesive portion (thereby making two parallel score lines along the dotted lines depicted as #30 in Fig. 1) as taught by Hibler in order to allow one side of the liner to be peeled and the tape aligned with the corner and then to subsequently allow the second side of the liner to be peeled and pressed on the remainder of the corner.

Tuoriniemi teaches a masking tape for corner structures wherein the tape is folded upon itself in a transverse direction (see Figs. 6(a-e)). Tuoriniemi teaches the rolled construction wherein the tape is folded upon itself for the purpose of allowing the outer adhesive layer to be bonded along one edge of the corner while subsequently allowing the tape to be unfolded and bonded along the other edge of the corner – thereby simplifying the application process (Col. 4, lines 46-54). It would have been obvious through routine experimentation to one of ordinary skill in the art at the time applicants invention was made to have provided a roll of adhesive tape used for corner structures with a tape in a folded over relationship for the purpose of allowing the outer adhesive layer to be bonded along one edge of the corner while subsequently allowing the outer adhesive layer to be bonded along the other edge of the corner – thereby simplifying the application process – as taught by Tuoriniemi.

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Therefore, it would have been obvious to one of ordinary skill in the art at the time applicants invention was made to have modified Vitale by providing the rolled tape in a folded over relationship as taught by Tuoriniemi in order allow the outer adhesive layer to be bonded along one edge of the corner while subsequently allowing the outer adhesive layer to be bonded along the other edge of the corner – thereby simplifying the application process.

7. Claims 1-3, 5-6, 10-16, 19-21, 23-24, and 28-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Loscuito (#5,264,775) in view of Hibler (#6,001,200) and Tuoriniemi (#6,444,307).

Loscuito teaches a pressure-sensitive tape for closing, sealing, or gluing joints in house construction, including joints in corners and edges (Col. 2, lines 14-17), comprising a backing layer (Col. 1, lines 3-6), and adhesive layer supported by the backing layer (Col. 1, lines 6-8), and a peelable protective film resting on the adhesive layer (Col. 2, lines 8-10). The adhesive tape has multiple longitudinal perforated sections wherein the perforations extend through all three layers (see Fig. 1; Col. 3, lines 25-28). The perforations are at least 3 millimeters in diameter and are in the shape of circles, ovals, stars, or any other desired shape (Col. 2, lines 32-43). The backing comprises paper (which is an open pored material) (Col. 2, lines 3-6) which exhibits good adhesion properties for plaster (Col. 3, lines 20-23) and the adhesive layer is a pressure-sensitive acrylate adhesive (Col. 2, lines 6-7). The tape is at least 3 to 4cm wide when not folded (Col. 2, lines 44-45). A non-adhesive central strip is provided and the perforated longitudinal sections are at a distance from the central strip (“fold line”; Col. 2, lines 10-13). The tape is in roll form (see Fig. 1).

Loscuito fails to teach the protective layer comprising multiple slits and the tape being folded upon itself in a transverse direction along a slit.

Hibler, however, teaches a protective tape for protecting corners wherein the protective film is slit ("scored") along the adhesive portions of the substrate. Hibler teaches the use of slits along the protective film layer for the purpose of allowing one side of the liner to be peeled and the tape aligned with the corner and then to subsequently allow the second side of the liner to be peeled and pressed on the remainder of the corner (Col. 4, lines 30-35). It would have been obvious through routine experimentation to one of ordinary skill in the art at the time applicants invention was made, motivated by the desire to properly adhere a tape along the corner portion of a wall, to have provided slits along the adhesive portions a protective film layer of a tape substrate for the purpose of allowing one side of the liner to be peeled and the tape aligned with the corner and then to subsequently allow the second side of the liner to be peeled and pressed on the remainder of the corner as taught by Hibler.

Therefore, it would have been obvious to one of ordinary skill in the art at the time applicants invention was made to have modified Loscuito by slitting the protective film layer along each adhesive portion (thereby making two parallel score lines along each side of the fold line (Fig. 1, #22)) as taught by Hibler in order to allow one side of the liner to be peeled and the tape aligned with the corner and then to subsequently allow the second side of the liner to be peeled and pressed on the remainder of the corner.

Tuoriniemi teaches a masking tape for corner structures wherein the tape is folded upon itself in a transverse direction (see Figs. 6(a-e)). Tuoriniemi teaches the rolled construction wherein the tape is folded upon itself for the purpose of allowing the outer adhesive layer to be



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bonded along one edge of the corner while subsequently allowing the tape to be unfolded and bonded along the other edge of the corner – thereby simplifying the application process (Col. 4, lines 46-54). It would have been obvious through routine experimentation to one of ordinary skill in the art at the time applicants invention was made to have provided a roll of adhesive tape used for corner structures with a tape in a folded over relationship for the purpose of allowing the outer adhesive layer to be bonded along one edge of the corner while subsequently allowing the outer adhesive layer to be bonded along the other edge of the corner – thereby simplifying the application process – as taught by Tuoriniemi.

Therefore, it would have been obvious to one of ordinary skill in the art at the time applicants invention was made to have modified Loscuito by providing the rolled tape in a folded over relationship as taught by Tuoriniemi in order allow the outer adhesive layer to be bonded along one edge of the corner while subsequently allowing the outer adhesive layer to be bonded along the other edge of the corner – thereby simplifying the application process.

8. Claims 4 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vitale (#4,792,473) in view of Hibler (#6,001,200) and Tuoriniemi (#6,444,307), and further in view of Porter et al. (#5,895,301).

Vitale teaches a pressure-sensitive adhesive tape as detailed above. The backing layer comprises paper. Although Vitale fails to explicitly state that the tape is hand tearable, it is notoriously well known in the art that paper is hand tearable as evidenced by Porter et al. (Col. 1, lines 64-65). Therefore, given the support of Porter et al., the paper backing inherently possesses the ability to be hand torn transversely to the longitudinal direction of the tape.

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9. Claims 4 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Loscuito (#5,246,775) in view of Hibler (#6,001,200) and Tuoriniemi (#6,444,307), and further in view of Porter et al. (#5,895,301).

Loscuito teaches a pressure-sensitive adhesive tape as detailed above. The backing layer comprises paper. Although Vitale fails to explicitly state that the tape is hand tearable, it is notoriously well known in the art that paper is hand tearable as evidenced by Porter et al. (Col. 1, lines 64-65). Therefore, given the support of Porter et al., the paper backing inherently possesses the ability to be hand torn transversely to the longitudinal direction of the tape.

10. Claims 8, 17-18, 26, and 33-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vitale (#4,792,473) in view of Hibler (#6,001,200) and Tuoriniemi (#6,444,307), and further in view of Avery (#2,373,092), Blok et al. (#6,177,163), and Samuelson (#5,736,001).

Vitale teaches a roll of a pressure-sensitive adhesive tape as detailed above. Vitale fails to teach a cardboard dispenser comprising at least one outlet slot for the tape. It is notoriously well known in the art, however, to provide a dispenser for tapes and/or labels in roll form as evidenced by Avery (Col. 1, lines 31-40; Col. 2, lines 52-55). Avery teaches the use of a cardboard dispenser for the purpose of allowing the roll of tape to be kept in a container that subsequently allows the tape to be dispensed from the container (Col. 1, lines 31-40). Further evidence of the notoriously well known use of dispensers for rolled tape can be found in both Samuelson (see Fig. 1) and Blok et al. (see Fig. 1). It would have been obvious through routine experimentation to one of ordinary skill in the art at the time applicants invention was made to have provided a roll of tape with a dispenser for the purpose of allowing the roll of tape to be

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kept in a container that subsequently allows the tape to be dispensed through the container as taught by Avery.

Therefore, it would have been obvious to one of ordinary skill in the art at the time applicants invention was made to have modified Vitale by situating the roll of pressure-sensitive tape inside a dispenser as taught by Avery in order to allow the roll of tape to be kept in a protective container that subsequently allows the tape to be dispensed through the container.

11. Claims 8, 17-18, 26, and 33-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Loscuito (#5,246,775) in view of Hibler (#6,001,200) and Tuoriniemi (#6,444,307), and further in view of Avery (#2,373,092), Blok et al. (#6,177,163), and Samuelson (#5,736,001).

Loscuito teaches a roll of a pressure-sensitive adhesive tape as detailed above. Loscuito fails to teach a cardboard dispenser comprising at least one outlet slot for the tape. It is notoriously well known in the art, however, to provide a dispenser for tapes and/or labels in roll form as evidenced by Avery (Col. 1, lines 31-40; Col. 2, lines 52-55). Avery teaches the use of a cardboard dispenser for the purpose of allowing the roll of tape to be kept in a container that subsequently allows the tape to be dispensed from the container (Col. 1, lines 31-40). Further evidence of the notoriously well known use of dispensers for rolled tape can be found in both Samuelson (see Fig. 1) and Blok et al. (see Fig. 1). It would have been obvious through routine experimentation to one of ordinary skill in the art at the time applicants invention was made to have provided a roll of tape with a dispenser for the purpose of allowing the roll of tape to be kept in a container that subsequently allows the tape to be dispensed through the container as taught by Avery.

Therefore, it would have been obvious to one of ordinary skill in the art at the time applicants invention was made to have modified Loscuito by situating the roll of pressure-sensitive tape inside a dispenser as taught by Avery in order to allow the roll of tape to be kept in a protective container that subsequently allows the tape to be dispensed through the container.

### ***Response to Arguments***

12. Pursuant to the Applicant's remarks and amendments in paper no. 8 and paper no. 12 (supplemental amendment), the 35 U.S.C. 112, first and second paragraph rejections of Claims 1-6, and 10-18 as well as the objection of Figs. 1-4 from the previous office action have been withdrawn by the Examiner. The Examiner has maintained, however, the 35 U.S.C. 112, first paragraph rejections of claims 7 and 9 and the 35 U.S.C. 112, second paragraph rejection of claim 8 from the previous office action.

13. Applicant's arguments filed April 11, 2003 (paper no. 8) with regards to the 35 U.S.C. 103(a) rejections from the previous office action along with the supplemental amendment (paper no. 12) filed April 28, 2003 have been fully considered but they are not persuasive.

The Applicant's first contention is that the teachings of Vitale and Loscuito fail to teach a tape that functions to close off, seal, or glue joints in house construction due to the holes being placed in the center of the tape (Vitale) or because of the overall pattern of holes (Loscuito). The limitation to which the Applicant relies upon, however, is recited in claim 1 (i.e., "A pressure-sensitive tape *for closing, sealing, or gluing joints in house construction*") as an intended use. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

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Furthermore, the Examiner disagrees that the placement of the holes in the center of the tape precludes the tape from sealing a joint. Vitale explicitly teach that “the tape is used to seal gaps between sections of wallboard... the tape is applied directly over the seam where the sections of the wallboard meet and a coat of gypsum compound is applied over the tape. The perforations in the center of the tape allow the gypsum to pass through the tape and fill the gaps between the sections of wall-board, thus eliminating the need for the bedding coat of gypsum compound (Col. 1, line 65 to Col. 2, line 5).” With respect to the teachings of Loscuito, Loscuito explicitly teach that the resulting end product is free from cracking, peeling, bubbles, or other defects (Col. 3, line 65 to Col. 4, line 23) and thus implicitly teaches that the joints are closed off and sealed.

Second, in response to the Applicant’s piecemeal analysis of the references, it has been held that one cannot show non-obviousness by attacking references individually where, as here, the rejections are based on combinations of references. *In re Keller*, 208 USPQ 871 (CCPA 1981). The Examiner agrees that taken individually, none of the cited prior art of record teaches every element of the Applicant’s claimed invention. The test for combining references, however, is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. *In re McLaughlin*, 170 USPQ 209 (CCPA 1971). References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. *In re Bozek*, 163 USPQ 545 (CCPA 1969). Here, taking the teachings of Vitale, Hibler, Touriniemi, Loscuito, Porter, Avery, Blok et al., and Samuelson as a whole, one of ordinary skill in the art at the time Applicant’s invention was made would have rendered the Applicant’s claimed invention obvious in view of the aforementioned teachings. The Examiner refers the Applicant to the above

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rejections under 35 U.S.C. 103(a) for the detailed reasons as to why it would have been obvious to have modified the primary references in view of the secondary reference teachings.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian P. Egan whose telephone number is 703-305-3144. The examiner can normally be reached on M-F, 8:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Y. Pyon can be reached on 703-308-4251. The fax phone numbers for the

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organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

  
BPE  
July 9, 2003



**WILLIAM P. WATKINS III  
PRIMARY EXAMINER**